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Art Unit: 3656

13. REQUEST FOR RECONSIDERATION/OTHER

In response to Applicant's remarks, the Examiner respectfully submits, *inter alia*, the following.

Shigeru

It is well settled that the claims drawn to an apparatus must distinguish from prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997); *In re Danly*, 120 USPQ 528 (CCPA 1959); *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987); and MPEP § 2114. The Court in *Schreiber* has laid Applicant's arguments to rest by pointing out that: "[a]lthough *Schreiber* is correct that Harz does not address the use of the disclosed structure to dispense popcorn, *the absence of a disclosure relating to function does not defeat the Board's finding of anticipation.*" In fact, the Court in *Schreiber* emphasized:

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("*[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.*"). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

See also *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); *In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

Art Unit: 3656

In addition, as noted, an anticipatory reference needs not duplicate word for word what is in the claims. Anticipation can occur when a claimed limitation is “inherent” or otherwise *implicit* in the relevant reference. *Standard Haven Products Inc. v. Gencor Industries, Inc.*, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). Further, it is well settled that an anticipatory reference needs not provide such explanation to anticipate what artisan would know as evidenced by standard textbook. *In re Opprecht*, 12 USPQ2d 1235 (Fed. Cir. 1989).

In the instant case, Shigeru’s second section is made of flexible material similarly to Applicant’s second section (Translation, pp. 1 and 4 of the translation). Thus, Shigeru’s second section is capable of deforming/flexing out of interference with the vehicular operator's ability to operate the steering wheel 2 when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel 2 in the same manner as Applicant’s second section due to their structural similarity. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986) and *In re Schreiber, supra*.

In view of the foregoing, the Examiner respectfully declines Applicant's request to withdraw the rejection based on Shigeru.

Van Arsdel

The rejection based on Van Arsdel was withdrawn in the last final rejection on May 13, 2010. Therefore, Applicant’s arguments about Van Arsdel are deemed to be moot.